

REMARKS

For the first restriction requirement which separated the claims into Groups I and II, Applicant hereby cancels Claims 1-12 and 30 of Group I. Applicant preserves its right to pursue a divisional application for these claims.

In the latest Office Action, the Examiner issued a further restriction requirement creating new Groups III and IV. The independent claim in Group III is Claim 13, and the independent claim in Group IV is Claim 22. The Examiner stated that restriction was proper because the combination of Group III "as claimed does not require a process of applying a film lubricant [to the] inner surface of the swage". The Examiner further stated that the subcombination of Group IV "has separate utility such as applying a film lubricant [to the] inner surface of the swage".

First, it should be clarified that Claim 22 does not claim the step of applying a film lubricant to the inner surface of the "swage;" rather, a film lubricant is claimed as being applied to the inner surface defining an opening in a distal end of the actuator arm. What appears to be expressed by the Examiner is that the claims are interpreted as requiring application of a film lubricant to the inner surface of the swage boss, the swage boss being defined as the "swage."

In order to traverse this latest restriction requirement, Applicant has amended Claim 22 to delete the limitation of applying a lubricant film coating to the inner surface of the opening in the actuator arm, thereby rendering the Examiner's restriction moot. Accordingly, as now claimed in Claim 22, the subcombination can no longer be argued as specifically providing a method with separate utility, such as applying a film lubricant to the inner surface of any member, whether it be the inner surface of the swage boss or the inner surface defining the opening in the distal end of the actuator arm. The particular step of applying a lubricant film coating to the inner surface of the opening in the distal end of the actuator arm is now included in new dependent Claim 30. Therefore, Claim 22 can now be considered a linking claim, and restriction should be withdrawn. Accordingly, Applicant respectfully requests examination on the merits for Claims 22-29.

The Examiner commented that a listing of the references in the specification is not a proper form for an Information Disclosure Statement. The only reference mentioned in the specification is the U.S. Patent No. 5,879,578. This reference has already been cited by the

Examiner. Therefore, no Information Disclosure Statement is required to make this particular reference of record.

The abstract of the disclosure was objected to because the Examiner contended that it did not sufficiently describe the claimed invention. Furthermore, the Examiner objected to the title of the invention as not being descriptive. The abstract of the disclosure has been rewritten to more fully describe the claimed invention. The title of the invention has also been amended to comport with the Examiner's kind suggestion, as well as adding language regarding the subject matter of independent Claim 2 relating to reducing torque out retention values. Therefore, the objections to the specification should be withdrawn.

Claims 13-15 and 18-21 were rejected under Section 103 as being unpatentable over Chung et al. in view of Liu. The Examiner contended that Chung disclosed each of the features in the claims, except for depositing a film lubricant upon at least an outer surface of the swage boss. The Examiner then contended that Liu teaches a portable automobile grease suction machine including a process of applying a film lubricant on a plane of friction so as to reduce the force of friction during a production operation. Accordingly, the Examiner concluded that it was proper to combine the references to reject the claims. Applicant respectfully traverses the rejection.

The Examiner has recognized that Chung et al. does not teach or disclose lubricating the outer surface of the swage boss. Chung is solely directed to providing lubricated swage balls for reducing the forces imparted on the actuator which occur during swaging. Chung et al. is absolutely silent as to lubricating any other parts, to include any parts of the actuator assembly. Furthermore, Chung does not even passively mention or imply that an actuator assembly may be subject to a de-swaging process, or the problems associated therewith. As for Liu, Applicant disagrees that this reference discloses any type of process for applying a film lubricant of any type. In the Liu reference, the passage which the Examiner refers to (column 1, lines 12-25) simply describes the fact that automobiles must periodically have their lubricants changed due to the deleterious effects of friction which may occur within moving parts of the automobile. The actual invention that is disclosed in this reference is a portable automobile grease suction

machine which is used to forcibly remove various lubricants from an automobile when one wishes to replace the lubricant fluids in the automobile. This reference is truly non-analogous art as it does not even minimally teach or disclose how a lubricant is applied to any type of machine or structure, much less lubrication of a disk drive. To the extent the Examiner relies upon this reference for some universal teaching that lubrication is always a preferable option, or that a lubricant is known to be applied to all surfaces which may come in contact with one another, Applicant also traverses this finding as well. Particularly in disk drives, there are circumstances in which lubrication must be avoided, or at least there must be special lubricants chosen and applied in special ways to prevent unnecessary disk drive contamination. Absent Liu disclosing any type of subject matter relating to lubrication of a disk drive, the Examiner cannot properly combine the references to obviate the present invention. As stated above with respect to the Chung reference, the only teaching which is found in that reference regarding lubrication is lubrication of the swage balls themselves, and not lubrication of any part of the actuator, or any other parts of the elements that are used in a swaging process or de-swaging process. The presently claimed invention does not relate to actual lubrication of the swage ball or the surfaces which come into contact with the swage ball; rather, the claimed invention relates to lubrication of those parts which do not come into contact with the swage ball, and are lubricated for purposes of reducing torque out retention values in a subsequent de-swaging process. //

In independent Claim 13, the depositing step requires that a film lubricant be applied at least to an outer surface of the swage boss. As discussed above, Chung nor Liu disclose any type of lubricant application except for lubrication of the swage ball which never makes contact with the outer surface of the swage boss, but only the inner surface of the swage boss. As for independent Claim 22, this claim also requires that a lubricant film coating be applied to the outer surface of the swage boss. Therefore, these claims are clearly allowable over the prior art of record. Claims 14-21, Claims 23-29, and Claim 31 depend directly/indirectly from independent Claims 13 and 22. These dependent claims add further features to the claimed invention. Therefore, each of these dependent claims should also be allowed.

Application No. 09/975,593

Claims 16 and 17 were rejected under Section 103 as being unpatentable over Chung in view of Liu, and further in view of Fisher. Fisher clearly fails to remedy the deficiencies set forth above with respect to Chung and Liu. Furthermore, Applicant traverses this rejection to the extent Fisher is properly combinable with Chung and/or Liu. Providing lubrication for a distance measuring gauge and the components thereof do not relate to or otherwise lend itself to the teachings of lubrication in the area of disk drives. Therefore, this rejection should also be withdrawn.

Applicant has made a sincere effort to place this application in a condition for allowance; therefore, such favorable action is earnestly solicited. The Examiner is urged to contact the undersigned if there are any matters which would further advance allowance.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: 

Brent P. Johnson
Registration No. 38,031
1560 Broadway, Suite 1200
Denver, Colorado 80202-5141
(303) 863-9700

Date: 7/1/03